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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/716,329	11/18/2003	Fred H. Burbank	R0368-04000	5236				
7590 Edward J. Lynch DUANE MORRIS LLP One Market Spear Tower, Suite 2000 San Francisco, CA 94105		08/07/2007	<table border="1"><tr><td colspan="2">EXAMINER</td></tr><tr><td colspan="2">TYSON, MELANIE RUANO</td></tr></table>		EXAMINER		TYSON, MELANIE RUANO	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/716,329

Applicant(s)

BURBANK ET AL.

Examiner

Melanie Tyson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-13, 40-43, 45, 46 and 50-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-13, 40-43, 45, 46, and 50-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This action is in response to Applicant's amendment received on 20 June 2007.

Corrections made to the claims have been accepted.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 20 June 2007 has been entered.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 10-13, 40-43, 45, 46, and 50-53 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
1. Claims 40-43, 45, 46, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lakatos (4,997,419). Lakatos discloses an intravaginal tenaculum-like device (see entire document) comprising an elongated guide rail (12), a movable collar (23), a medical instrument (member 62 in that it engages the cervix and seals the uterine cavity; for example, see column 1, lines 23-25, column 2, lines 10-13, and column 6, lines 40-42) mounted to the guide rail (12) distal to the movable collar (23), a tissue grasping assembly comprising a first elongated member secured to the guide rail (12) and a second elongated member pivotally connected to the first elongated member (for example, see Figure 9), and a securing member (102). Lakatos further discloses the guide rail (12) has threads on an exterior portion and the collar has internal threads (for example, see column 3, lines 65-68).

Lakatos fails to disclose the distal end of the elongated member is secured to a distal portion of the guide rail distal to the collar. With respect to claim 40, it would have been obvious to one of ordinary skill in the art at the time the invention was made to secure the elongated member to a distal portion of the guide rail, since such a configuration is well known in the art (for example, see Mohajer 5,464,409, Figure 7). With further respect to claims 46 and 54, it would have been obvious to one of ordinary skill in the art at the time the invention was made to secure the elongated member to a distal portion of the guide rail distal to the collar, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art.

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Furthermore, it would have been obvious to modify the sizes of the components (such as the shaft, tissue grasping assembly, etc.) to accommodate the reversal of essential working parts, since a change in size is generally recognized as being within the level of ordinary skill in the art.

2. Claims 10-13, 50-53, and 55-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lakatos in view of Mohajer (5,464,409). Lakatos discloses a device as described above, however, fails to disclose the tip of the guide rail comprises expandable bifurcated portions. Mohajer discloses an intravaginal tenaculum-like device (see entire document). Mohajer teaches a uterine manipulator (10) comprising a guide rail (18), wherein the distal tip is expandable and split into bifurcated portions (for example, see column 5, lines 49-56) having different radii of curvature. It would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the distal tip of Lakatos as taught by Mohajer in order to provide a device that can hold itself in place during the procedure by engaging portions of the uterus, uterine cavity, and cervix (column 4, lines 48-53 and column 5, lines 45-49), thus facilitating the procedure.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571) 272-9062. The examiner can normally be reached on Monday through Thursday 9-5:30, Fridays 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson *MT*  
August 1, 2007

*Tan-Uyen Ho*  
(JACKIE) TAN-UYEN HO  
SUPERVISORY PATENT EXAMINER  
8/3/07